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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,967	07/18/2003	Leonard Edward Bogan JR.	A01231A	4012

21898 7590 08/10/2004
ROHM AND HAAS COMPANY
PATENT DEPARTMENT
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EXAMINER

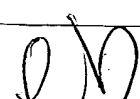
HAILEY, PATRICIA L

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/622,967	Applicant(s) BOGAN ET AL.	
	Examiner Patricia L. Hailey	Art Unit 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/24/03</u> . | 6) <input type="checkbox"/> Other: _____ |

Applicants' Preliminary Amendment, filed on July 18, 2003, has been made of record and entered. In this amendment, claims 1-3 have been canceled, and claims 4-6 have been amended. No claims have been added.

Claim 4 has been amended to become an independent claim, as this claim originally depended from canceled claim 1. Claims 5 and 6 have been amended to correct typographical error.

Claims 4-6 remain pending in this application.

Claim Objections

1. Claim 4 is objected to because of the following informalities:

In line 13 of claim 4, "45C" should be changed to "45°C".

Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Art Unit: 1755

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claim 4 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,407,031.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 4 in the instant application and claim 1 in the '031 patent recite almost the same empirical formula, with the exception that the elements respectively represented by N, X, and Z in the instant application are not exactly the same as that represented by these elements in the patented claim (e.g., N in the patented claim recites elements additional to those recited in Applicants' claim 4). Further, Mo and W in the instant application are encompassed by A and M in the patented claim. The molar values for a through d and f of both the instant claim and the patented claim are identical, except that the value for e in the instant application (0 to 0.1) encompasses that for e in the patented claim (0.001 to 0.1).

Additionally, the process limitations of the '031 patent (see patent claim 4) are almost identical to those recited in Applicants' claim 4. Although Applicants' claim 4 recites that the compounds and at least one solvent are admixed at a temperature greater than or equal to 45°C, the patented claims are considered to

encompass any and every temperature range necessary to produce Patentees' catalyst.

4. Claim 4 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,407,280.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 4 in the instant application and claim 1 in the '280 patent recite almost the same empirical formula, with the exception that the elements respectively represented by N, X, and Z in the instant application are not exactly the same as that represented by these elements in the patented claim (e.g., N in the patented claim recites elements additional to those recited in Applicants' claim 4). Further, Mo and W in the instant application are encompassed by A and M in the patented claim. The molar values for a through d and f of both the instant claim and the patented claim are identical, except that the value for e in the instant application (0 to 0.1) encompasses that for e in the patented claim (0.001).

Additionally, the process limitations of the '280 patent (see patent claim 4) are almost identical to those recited in Applicants' claim 4. Although Applicants' claim 4 recites that the compounds and at least one solvent are admixed at a temperature greater than or equal to 45°C, the patented claims are considered to

encompass any and every temperature range necessary to produce Patentees' catalyst.

5. Claim 4 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,403,525.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 4 in the instant application and claim 1 in the '525 patent recite almost the same empirical formula, with the exception that the elements respectively represented by N, X, and Z in the instant application are not exactly the same as that represented by these elements in the patented claim (e.g., N in the patented claim recites elements additional to those recited in Applicants' claim 4). Further, Mo and W in the instant application are encompassed by A and M in the patented claim. The molar values for a through d and f of both the instant claim and the patented claim are identical, except that the value for e in the instant application (0 to 0.1) encompasses that for e in the patented claim (0.001).

Additionally, the process limitations of the '525 patent (see patent claim 5) are almost identical to those recited in Applicants' claim 4. Although Applicants' claim 4 recites that the compounds and at least one solvent are admixed at a temperature greater than or equal to 45°C, the patented claims are considered to

encompass any and every temperature range necessary to produce Patentees' catalyst.

In each of the aforementioned patents, it appears that the compositions recited therein could be the same as that respectively claimed, in view of the fact that Patentees' process limitations are almost identical to that recited in Applicants' claim 4, with the exception of Applicants' claimed temperature range of 45°C or greater.

6. Claims 5 and 6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,472,522.

Although the conflicting claims are not identical, they are not patentably distinct from each other because while both sets of claims are directed to processes for producing an unsaturated carboxylic acid (patent claims 1 and 3) and for producing unsaturated nitriles (patent claims 2 and 4), the claims of the '522 patent recite (1) catalysts having empirical formulae nearly the same as those respectively recited in Applicants' claims 5 and 6, and (2) the same process limitations regarding preparing the catalyst as those recited in Applicants' claims 5 and 6, with the exception that Applicants' claims 5 and 6 recite temperatures at which the compounds are admixed of "greater than or equal to 45°C" (claim 5) or "greater than or equal to 60°C" (claim 6). These temperature limitations are considered within the purview of the patented claims, given that the remaining process steps (both (a)

Art Unit: 1755

the processes for producing unsaturated carboxylic acid and unsaturated nitriles and (b) the processes for preparing the catalyst employed in said process) are nearly identical to those respectively recited in Applicants' claims 5 and 6.

7. Claim 5 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,710,207.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both Applicants' claim 5 and patented claim 1 are directed to processes for producing an unsaturated nitrile, and also recite comparable mixed metal oxide catalysts in the presence of which the processes are performed. The mixed metal oxide catalysts contain almost the same elements in the same atomic ratios, especially when the variable "e" in Applicants' claim 5 is 0 (zero).

The patented claim broadly encompasses Applicants' claim 5.

8. Claim 6 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 10 of copending Application No. 10/722,281.

Although the conflicting claims are not identical, they are not patentably distinct from each other because although both claims are directed to a process for the production of an unsaturated nitrile, and also recite comparable mixed metal oxide catalysts in the presence of which the processes are performed, the mixed

Art Unit: 1755

metal oxide catalysts of both applications recite the same elements represented by the variables A, M, and N, and X, with the exception that, '281 application, A and M include tungsten and cerium, respectively, N includes Se, and X contains the elements represented by X and Z in the instant application.

The respectively recited mixed metal oxide catalysts contain almost the same elements in the same atomic ratios, especially when the variable "e" in Applicants' claim 5 is 0 (zero).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

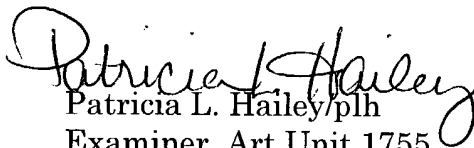
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Hailey whose telephone number is (571) 272-1369. The examiner can normally be reached on Mondays-Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on (571) 272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1755

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Patricia L. Hailey/plh
Examiner, Art Unit 1755
August 4, 2004


Mark L. Bell
Supervisory Patent Examiner
Technology Center 1700